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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,660	03/19/2001	Roman Efrain Vasquez Lipi	2119-109	9057

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ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
1425 K STREET, N.W.  
SUITE 800  
WASHINGTON, DC 20005

EXAMINER

BERMAN, ALYSIA

ART UNIT PAPER NUMBER

1617

DATE MAILED: 03/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/810,660

Applicant(s)

VASQUEZ LIPI, ROMAN EFRAIN

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 17, 18 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17, 18 and 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Receipt is acknowledged of the request for extension of time and amendment filed December 20, 2001. Claims 1-15, 17-18 and 22-23 have been amended. Claims 16 and 19-21 have been canceled. Claims 24-27 have been added. Claims 1-15, 17, 18 and 22-27 are pending.

#### ***Claim Rejections - 35 USC § 102***

2. In view of Applicant's amendments and remarks, the 35 U.S.C. 102 rejections have been withdrawn. The prior art of record does not disclose all of the components instantly claimed in one composition.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15, 17, 18, 22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,503,825 (Lane '825).

US '825 is directed to topical compositions that have healing properties. The compositions are particularly used for healing chapped, cracked, sunburned and windburned lips (abstract). The composition may comprise, as a vehicle, a mixture of any of mineral oil (liquid petroleum jelly excipient), vegetable oils such as castor oil, almond oil, olive oil and sunflower oil, animal oils such as cod liver oil, waxes such as beeswax and fatty acids, *inter alia* (col. 4, lines 18-53). Additional ingredients commonly

used in the art that may be included in the composition of US '825 include preservatives (col. 4, lines 54-57).

US '825 does not explicitly teach a composition comprising all of the components instantly claimed, the particular amounts of each component (claims 2-5 and 10-15), vitamins A, D or E (claims 6-15) or stearic acid (claim 18). All of the instantly claimed components are well known and commonly used in the art. It is within the skill in the art to combine well-known and commonly used components expecting to obtain an art useful composition. Stearic acid is a common fatty acid that is naturally found in animal and vegetable fats and is commonly used in cosmetics and pharmaceuticals. See Hawley, The Condensed Chemical Dictionary, 10<sup>th</sup> Ed., Van Nostrand Reinhold Company, New York, (1981), page 968. A composition containing the vegetable and animal oils instantly claimed would be expected to contain stearic acid. Absent evidence of unexpected results, the particular combination of commonly used components is considered obvious in view of the prior art.

Applicant discloses in the specification at page 4, lines 23-25, that cod liver oil contains vitamins A and D and at page 5, lines 4-7, that sunflower oil contains vitamin E. Therefore, a composition containing cod liver oil and sunflower oil would also contain vitamins A, D and E. It is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 198). Therefore, the amounts of ingredients are not considered critical to the invention. Absent evidence of unexpected results, the amounts of ingredients as instantly claimed are obvious in view of the prior art. Compositions

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containing the amounts of sunflower and cod liver oils as instantly claimed would be expected to contain the amounts of vitamins instantly claimed based on Applicants disclosure at pages 4 and 5 of the specification.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '825 using any desired combination of ingredients with the reasonable expectation of obtaining a composition suitable for topical cosmetic purposes.

5. Claims 1-15, 17, 18, 22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,503,825 (825) in combination with US 4,386,067 (067).

US '825 discloses all the limitations of the claims as stated in the 35 U.S.C. 103(a) rejection above. It does not explicitly teach that the oils and waxes are commonly used in the art.

US '067 discloses that oils commonly used in topical cosmetic compositions include sunflower, almond, olive, castor and fish-liver oils (col. 2, lines 39-51 and claims).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '825 using any combination of commonly used oils as disclosed in US '067 with the reasonable expectation of obtaining a composition suitable for topical cosmetic purposes.

6. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over either US 5,503,825 (825) alone or in combination with US 4,386,067 (067) as applied to

claims 1-15, 17, 18, 22 and 24-27 above, and further in view of US 5,597,849 (McGinity et al. 849)

US '825 and US '067 teach all the limitations of the claims as stated in the 35 U.S.C. 103(a) rejections above. Neither reference teaches butylhydroxytoluene.

US '849 discloses a composition for topical use that comprise butylhydroxytoluene (BHT), which is an art-recognized preservative, (col. 8, lines 24-30 and the claims). The compositions may also contain beeswax, sunflower oil, mineral oil, castor oil, stearic acid (col. 9, lines 53-67, col. 7, lines 55-67, the examples and the claims). The amount of beeswax is about 15-17% of the composition (examples). The composition contains from about 1-40% oils of any combination (col. 9, lines 58-62).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '825 using butylhydroxytoluene as the preservative for its known preservative and antioxidant properties.

### ***Response to Arguments***

7. Applicant's arguments filed December 20, 2001 have been fully considered but they are not persuasive.

8. Applicant appears to argue that it would not have been obvious for one of ordinary skill in the art to select the particular combination of components instantly claimed from the list of the prior art. This is not found persuasive because all of the components are well known and commonly used in the art. One of ordinary skill in the art would have selected any particular combination of these components in order to achieve a particular desired effect based on the known uses of each component.

Therefore, absent evidence to the contrary, nothing critical is seen in Applicant's particular combination.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Correspondence***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

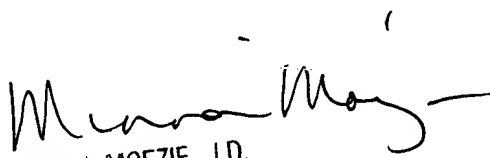
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on 703-308-4612. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.

  
Alysia Berman  
Patent Examiner  
March 1, 2002

  
MINNA MOEZIE, J.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600